

**REMARKS/ARGUMENTS**

Claims 14-22, 24, 26, 29-33 are pending.

Claims 14-21 are withdrawn from consideration.

Claims 1-11, 13 and 22-33 are rejected.

Claims 1-12, 23, 25, 27 and 28 are canceled without prejudice or disclaimer of the subject matter contained therein, Claims 22 and 31 have been amended. Support for these amendments can be found throughout the specification and drawings, as originally filed.

**35 USC §102(e) REJECTION**

Claims 1-5, 9-11 and 13 are rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,584,950 to Cunningham.

By this Amendment, Claims 1-13 are canceled, thereby rendering the rejection moot. Withdrawal of the rejection is respectfully requested.

**35 USC §103(a) REJECTION**

Claims 6-8 and 22-33 are rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,584,950 to Cunningham (hereinafter "Cunningham") in view of U.S. Patent No. 5,219,197 to Rich et al. (hereinafter "Rich"). The rejection is respectfully traversed.

By this Amendment, Claims 6-8 are canceled, thereby rendering the rejection moot.

In addition, independent Claim 22 is amended to recite the feature of a metal component having a closed cross section defining an interior and exterior and having a first opening defining edges and a second opening opposite said first opening for allowing a core tool to be inserted into said interior of said metal component during a molding operation.

Applicant agrees with the Office action that Cunningham fails to teach the use of a closed cross section metal component. However, the Office action asserts that it would have been obvious to modify the oil pan of Cunningham with the metal piece of Rich to meet the claimed invention. Applicant respectfully disagrees with this assertion.

According to *MPEP* §2143, to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the applied reference must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

It is respectfully submitted that the Office action fails to establish a *prima facie* case of obviousness because at least one of the three criteria have *not* been met. First, the combination of Cunningham and Rich does *not* disclose, teach or suggest all the claim limitations, as recited in Claim 22. Specifically, there is no mention in Cunningham or Rich of at least the feature of a metal component having a closed cross section defining an interior and exterior and having a first opening defining edges and a second opening opposite said first opening for allowing a core tool to be inserted into said interior of said metal component during a molding operation, as recited in amended independent Claim 22. Although Rich may teach a metal impact bar 20 having a closed cross section and an opening at one end thereof to insert a reinforcing insert 40, Rich does not mention a second opening opposite the first opening for allowing a core tool to be inserted into the interior of the metal component during a molding operation. Thus, the combination of Cunningham and Rich does *not* teach all the claim

limitations as recited in Claim 22, and the Office action fails to establish a *prima facie* case of obviousness.

Second, even if the combination of Cunningham and Rich discloses all the claim limitations, there is *no* motivation to combine the cited references because neither of the cited references recognizes the advantages discussed in the present application. As recently stated by the B.P.A.I.,

“Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”<sup>1</sup>

The Office action asserts that the motivation of modifying the Cunningham oil pan with the metal impact bar in Rich is to form an impact bar that resists deformation while being lightweight and effective and it is known to use closed cross section metal bars in the construction of automobiles. Applicant respectfully disagrees with this assertion.

Applicant agrees with the Office action that Rich teaches an impact bar that is closed in cross section. However, Cunningham is directed to reducing the weight of the oil pan by providing a support structure 12 fabricated with as little of metal material as possible. See *col. 6, lines 44-45*. As a result of this reduction in the use of metal, Cunningham requires the use of plastic reinforcing ribs 17 formed on the interior 23 of the support structure 12. See *col. 6, lines 1-16*. Thus, Cunningham teaches that the metal support structure 12 has a U-shaped cross section to reduce weight. The additional metal required to provide a support structure that would be closed in cross section would increase the weight of the oil pan and be in direct conflict with the teachings of Cunningham. Thus, Cunningham teaches away from modifying the support structure 12 from a U-shaped cross section to a support structure that is closed in

cross section, and therefore, there is no motivation to combine the cited references as asserted in the Office action to meet the claimed invention. For at least this additional reason, the Office action fails to establish a *prima facie* case of obviousness.

For at least this reason, amended independent Claim 22 is allowable over the applied art, taken singly or in combination. Claims 24, 26, 29-33, which depend from Claim 22, are likewise allowable over the applied art, taken singly or in combination. Withdrawal of the rejection is respectfully requested.

### **CONCLUSION**

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable consideration and prompt allowance of the application is earnestly solicited.

Should Examiner Nordmeyer believe anything further would be desirable in order to place the application in better condition for allowance; the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1612 (Warn Hoffmann Miller & LaLone). A duplicate copy of this letter is enclosed herewith.

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<sup>1</sup> *Ex Parte Gottling* (B.P.A.I. 2005) (unpublished).

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Respectfully submitted,

by   
RICHARD W. HOFFMANN  
Registration No. 33,711  
Phone: 248-364-4300

Warn Hoffmann Miller & LaLone PC  
PO Box 70098  
Auburn Hills, Michigan 48307

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